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OFFICE OF PETITIONS

In re Application of
Gerald W. INGRAM et al.
Application No. 09/847,999
Filed: May 4, 2001
Attorney Docket No. 43799-204796

ON PETITION

This is a decision on the petition under 37 CFR 1.183, filed July 25, 2005, seeking waiver of the rules.

The petition is **DISMISSED**.

Petitioner requests waiver of the rules as all rejections of the pending claims have been reversed by the Board of Patent Appeals and Interferences (BPAI) or timely rendered moot in view of the amendments to the claims in copending Application No. 09/594,786.

37 CFR 1.197 states:

- (a) After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application may require, to carry into effect the decision.
- (b) Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See § 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.
- (c) Termination of proceedings.

(1) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:

- (i) Where claims stand allowed in an application; or
- (ii) Where the nature of the decision requires further action by the examiner.

(2) The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the Court or review by civil action (§ 1.304) expires. If an appeal to the Court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is issued by the Court. A civil action is terminated when the time to appeal the judgment expires.

37 CFR 1.198 states:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

37 CFR 1.181(f) states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

The issue at hand is not what actions petitioner has taken in another patent application; rather it is whether petitioner has properly responded to the decision by the BPAI mailed May 26, 2005. The BPAI decision affirmed the examiner's provisional rejection of claims 31-33 under 35 U.S.C. 101. Under the rules of practice before the USPTO petitioner may have: (1) requested rehearing under 37 CFR 41.52; (2) timely filed an appeal to the Court or review by civil action under 37 CFR 1.304; or (3) filed an RCE under 37 CFR 1.114. Petitioner has done neither.

Petitioner failed to request rehearing under 37 CFR 41.52 while the case was still before the BPAI, and therein seek directly from the BPAI guidance or amplification regarding the above decision, as did the appellants in Ex parte Gartin, 90 USPQ 392, 395 (Bd. Pat. App. 1950) and in Ex parte Druey, 145 USPQ 219, 221 (Bd. Pat. App. 1964).

Petitioner further failed to file an RCE under 1.114 per 37 CFR 1.198 seeking to reopen prosecution before the examiner. Rather petitioner merely filed a petition under 37 CFR 1.183, which did not of itself toll the period for seeking judicial review under 37 CFR 1.04. See 1.181(f). Furthermore, any attempt at reopening of prosecution must comply with 37 CFR 1.198. See e.g., Ex parte Bourne, 1904 Dec. Comm'r Pat. (1904) (reopening refused where applicant suggests that proposed claims are patentable but where no tribunal of the USPTO has ever suggested that the proposed claims would be allowable). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing--or not filing-- papers).

Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

However failure to know and properly apply the rules of practice before the USPTO is not a basis for seeking waiver of the rules under 1.183. Furthermore, extraordinary relief will not be considered where the rules of practice already provide an avenue for relief. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). Here, as noted above petitioner could have sought to reopen prosecution before the examiner by way of e.g. 37 CFR 1.114. Further in this regard, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). That is, the patent statute at 35 U.S.C. § 132(b) (and its promulgating regulation 37 CFR 1.114) provides a specific mechanism whereby an applicant may petition the USPTO to reopen prosecution. Since there is a specific mechanism in place to remedy the requested relief then it is inappropriate for the USPTO to contemplate circumventing that mechanism by creating another remedy. Likewise as the statute provides at §41(a)(7) a mechanism for revival of an inadvertently abandoned application, it would be an improper exercise of 37 CFR 183 and seek to forestall, or overcome abandonment as the petition requests.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099 or in his absence, the undersigned at (571) 272-3217.

Application No. 09/847,999

The application file is being referred to Technology Center AU 2177 for consideration of processing this case as an **abandonment** in view of petitioners failure to file an appropriate response to the decision mailed May 26, 2005.

A handwritten signature in black ink, appearing to read "Brian Hearn". The signature is fluid and cursive, with a small 'H' at the end of the last name.

Brian Hearn
Petitions Examiner
Office of Petitions